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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,470	04/02/2001	David Lawrence	3499-107	1341
27383	7590	11/06/2003	EXAMINER	
CLIFFORD CHANCE US LLP 200 PARK AVENUE NEW YORK, NY 10166			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/825,470	LAWRENCE, DAVID
	Examiner Jan Mooneyham	Art Unit 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 02 April 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/7                    6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This is in response to the applicant's communication filed on April 2, 2001, wherein claims 1-23 are pending.

### ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on July 12, 2002 and March 24, 2003 are being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 reads on a computer data signal. This signal is not generated by the steps but instead causes the computer to perform the steps.

### ***Claim Rejections - 35 USC § 101***

4. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 only recites an abstract idea. The recited steps of merely receiving information, structuring the information according to risk assessment factors, assigning a risk value, weighing the risk factors, and calculating a risk quotient does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to determine the risk related to a legal action.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble

that the method is "computerized". Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter. Claims 2-15 read on claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Heckman et al (US Pat. 5,875,431) (hereinafter referred to as Heckman).

***Referring to Claims 1, 16, 20, 21 and 22:***

Heckman discloses a method, system, and a computer medium for managing risk related to a legal action, comprising:

receiving information relating to a legal action (col. 10, line 65 thru col. 11, line 17, Fig. 3 (33,36));  
construction the information received according to risk assessment factors (col. 6, lines 50-54, col. 7, lines 4-13)

assigning a risk value to the information structured as risk assessment factors (col. 5, lines 10-16, col. 7, lines 4-13, lines 36-39, col. 20, lines 49-55, col. 21, lines 3-7, col. 22, lines 51-53, Fig. 3 (35));

weighing the risk factors according to relative importance (col. 18, lines 27-32); and calculating a risk quotient based upon the weighted risk factors and the risk value (col. 20, line 61 thru col. 21 line 2) and wherein said risk quotient is a numerical value (col. 20, lines 64-67).

**Referring to Claims 2, 5-9 and 15:**

Heckman discloses a method, system, and computer medium wherein a suggested action is generated responsive to the risk quotient and the information received (col. 5, lines 64-67, col. 6, lines 13-17, lines 45-48).

**Referring to Claims 3 and 4:**

Heckman discloses storing data indicative of the information received, the risk quotient and the suggested action; generating a report comprising the stored data; the report comprising information received relating to legal exposure and actions taken responsive to the risk quotient (Fig. 3, 4, 5-2 (62)).

**Referring to Claims 10-12 and 17:**

Heckman further discloses wherein the information received comprising the identities of the parties named in a litigation (col. 8, lines 5-20), and wherein the information received comprises venue for a legal action (col. 8, lines 21-36, col. 16, lines 59-60, col. 15, lines 21-22) and wherein the information received is gather electronically (col. 12, lines 49-54).

**Referring to Claims 13 and 14:**

Heckman further discloses the step of aggregating risk quotients relating to an entity and assessing a level of risk related to legal actions to which the entity is exposed and calculating an average risk quotient associated with an entity (.col. 15, lines 54-57, col. 25, lines 10-15)

**Referring to Claim 18 and 19:**

Heckman further discloses wherein the network access device is a personal computer or a wireless handheld device .(Fig. 2, col. 19, lines 25-34).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ryan (US Patent 6,470,319) discloses a system for synthesizing data and making a recommendation.

PCT WO 00/17799 discloses a system for modeling and scoring risk assessment.

ProQuest -The Changing Nature of Risk and the Challenges to Sound Risk Management in the New Global Financial Landscape.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JAM

*John G. Weiss*  
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